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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
09/551,252	04/18/2000	Adolf Brodbeck	(K) 53 928	1754

7590 07/28/2008  
M Robert Kestenbaum  
11011 Bermuda Dunes NE  
Albuquerque, NM 87111

EXAMINER
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DEXTER, CLARK F

ART UNIT	PAPER NUMBER
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3724

MAIL DATE	DELIVERY MODE
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07/28/2008

PAPER

**Please find below and/or attached an Office communication concerning this application or proceeding.**

The time period for reply, if any, is set in the attached communication.

<b>Office Action Summary</b>	<b>Application No.</b>	<b>Applicant(s)</b>	
	09/551,252	BRODBECK ET AL.	
	<b>Examiner</b>	<b>Art Unit</b>	
	Clark F. Dexter	3724	

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

### Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

### Status

- 1) ☒ Responsive to communication(s) filed on 07 April 2008.
- 2a) ☒ This action is **FINAL**.                      2b) ☐ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

### Disposition of Claims

- 4) ☒ Claim(s) 10,20-34 and 36-40 is/are pending in the application.
- 4a) Of the above claim(s) 20-34 and 36-38 is/are withdrawn from consideration.
- 5) ☐ Claim(s) \_\_\_\_\_ is/are allowed.
- 6) ☒ Claim(s) 18,39 and 40 is/are rejected.
- 7) ☐ Claim(s) \_\_\_\_\_ is/are objected to.
- 8) ☐ Claim(s) \_\_\_\_\_ are subject to restriction and/or election requirement.

### Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☒ The drawing(s) filed on 07 April 2008 is/are: a) ☒ accepted or b) ☐ objected to by the Examiner.  
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).  
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

### Priority under 35 U.S.C. § 119

- 12) ☒ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☒ All    b) ☐ Some \*    c) ☐ None of:
1. ☒ Certified copies of the priority documents have been received.
  2. ☐ Certified copies of the priority documents have been received in Application No. \_\_\_\_\_.
  3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

\* See the attached detailed Office action for a list of the certified copies not received.

### Attachment(s)

- |  |   |
|--|---|
| 1) <input type="checkbox"/> Notice of References Cited (PTO-892)                     | 4) <input type="checkbox"/> Interview Summary (PTO-413)           |
| 2) <input type="checkbox"/> Notice of Draftsperson's Patent Drawing Review (PTO-948) | Paper No(s)/Mail Date. _____                                      |
| 3) <input type="checkbox"/> Information Disclosure Statement(s) (PTO/SB/08)          | 5) <input type="checkbox"/> Notice of Informal Patent Application |
| Paper No(s)/Mail Date _____  | 6) <input type="checkbox"/> Other: _____                          |

### **DETAILED ACTION**

1. The amendment filed on April 7, 2008 has been entered.

#### ***Specification***

2. The amendment filed April 7, 2008 is objected to under 35 U.S.C. 132(a) because it introduces new matter into the disclosure. 35 U.S.C. 132(a) states that no amendment shall introduce new matter into the disclosure of the invention. The added material which is not supported by the original disclosure is as follows:

In replacement paragraph 0022, lines 4-5 do not appear to have support in the original disclosure, particularly since it is not clear how the bolt 39, which is shown as being supported on counter-holder 13 in Figure 2, can be movable in the direction of counter-holder 13.

In replacement paragraph 0025, support does not appear to be provided in the original disclosure for the description now provided in the last sentence of this paragraph.

In replacement paragraph 0028, support does not appear to be provided in the original disclosure for the description added in line 2, particularly since it is not clear as to what structure is being described.

Applicant is required to cancel the new matter in the reply to this Office Action.

3. The disclosure is objected to because of the following informalities:

In replacement paragraph 0020, last line, "e.g., " renders the description unclear and confusing, and it is suggested to change it to read --instead of--.

Appropriate correction is required.

***Claim Rejections - 35 USC § 112, 1<sup>st</sup> paragraph***

4. The following is a quotation of the first paragraph of 35 U.S.C. 112:

The specification shall contain a written description of the invention, and of the manner and process of making and using it, in such full, clear, concise, and exact terms as to enable any person skilled in the art to which it pertains, or with which it is most nearly connected, to make and use the same and shall set forth the best mode contemplated by the inventor of carrying out his invention.

5. Claims 18, 39 and 40 stand rejected under 35 U.S.C. 112, first paragraph, as failing to comply with the enablement requirement. The claim(s) contains subject matter which was not described in the specification in such a way as to enable one skilled in the art to which it pertains, or with which it is most nearly connected, to make and/or use the invention.

As stated in the previous Office actions, the operator of the ejector is not clear, particularly as to how it cooperates with the cutter and how it ejects a workpiece. More specifically:

- In paragraph 0018, a description is provided for a guide rail 16, a slide 17, and a threaded spindle 26 (not shown). However, the threaded spindle 26 is not shown, and the "corresponding guide element" which engages the threaded spindle is not shown and not sufficiently described. Thus, the connection between the slide 17 and the threaded

spindle 16 is unclear, and thus it is not clear how the slide 17 is moved on or with respect to the guide rail 16.

- In Figure 1, elements are shown as being connected to the guide rail 16; specifically, undriven cutting unit 30 is connected to the guide rail 16, fixed cutting unit 53 is connected to guide rail 16, and driven cutting unit 35 is connected to guide rail 16. However, it is not clear as to how the ejector 21 is connected to the guide rail 16. Further, it is not clear how the cutting units and the ejector are independently moved/positioned along the guide rail 16. For example, it is not clear how the ejector 21 is moved with respect to the counter-holder 13. If the ejector is supported for such movement on the guide rail 16, it is not clear how the ejector 21 can move from the initial position 23 to the ejector position 24 without interference (i.e., running into) at least the cutting units 30 and 53.
- Further, it is not clear whether the cutting units 30, 53 and 35 and the ejector 21 are each connected to the threaded spindle for movement along the guide rail 16. And if so, it is not clear how they are separately controllable and/or positionable to attain the described cutting arrangement(s) to produce different length tubes, particularly as now claimed in claim 39, lines 10-11.
- Additionally, the structure of the ejector 21 is not clear. It is not clear whether the ejector 21 and the cutting unit 35 are connected together as a single unit or whether they are separate, independently movable units.

If the ejector 21 is not connected to the cutting unit 35, then it is not clear how or even if it is connected to the guide rail 16 and/or the threaded spindle 26 (not shown). Also, the structure of the ejector is not clearly disclosed. For example, as stated above, groove 42 as shown in Figure 1 appears to indicate a protruding structure that is on the left side of what appears to be a groove or recess, indicated by numeral 41. Also, it is not clear as to what movable bolt 39 is connected and how it is arranged.

The above list of questions, which is not necessarily an exhaustive list, cover many of the questions raised by the present disclosure. As has been stated, it remains unclear as to what is the specific structure to perform the functions attributed to the present invention.

6. Claims 18, 39 and 40 are rejected under 35 U.S.C. 112, first paragraph, as failing to comply with the written description requirement. The claim(s) contains subject matter which was not described in the specification in such a way as to reasonably convey to one skilled in the relevant art that the inventor(s), at the time the application was filed, had possession of the claimed invention.

The original disclosure does not appear to provide support for a slide carrying “an ejector sleeve, having a driver element extendable in a direction toward the counter-holder and engaging a seating of said ejector sleeve” as now set forth in claim 39. In particular, it is not clear as to what disclosed structure the terms “driver element” and “seating” refer.

***Claimed Subject Matter With Respect to Prior Art***

7. Claims 18, 39 and 40 are considered to read over the prior art of record because the prior art or record does not teach or suggest the claimed combination of features including “a slide carrying the at least one cutting tool and ejector sleeve, having a driver element extendable in a direction toward the counter-holder and engaging a seating of said ejector sleeve” as now claimed. However, these claims **cannot** be considered to be “allowable” at this time due to the rejection(s) under 35 U.S.C. 112, 1<sup>st</sup> paragraph set forth in this Office action. Therefore, upon the claims being rewritten or amended to overcome the rejection(s) under 35 U.S.C. 112 set forth in this Office action, further consideration of these claims with respect to the prior art will be necessary.

***Response to Arguments***

8. Applicant's arguments filed June 22, 2007 have been fully considered but they are not persuasive for at least the reasons previously presented.

***Remarks***

9. Applicant is urged to contact the Examiner to discuss ways to expedite prosecution of the present application.

***Conclusion***

10. **THIS ACTION IS MADE FINAL.** Applicant is reminded of the extension of time policy as set forth in 37 CFR 1.136(a).

A shortened statutory period for reply to this final action is set to expire THREE MONTHS from the mailing date of this action. In the event a first reply is filed within TWO MONTHS of the mailing date of this final action and the advisory action is not mailed until after the end of the THREE-MONTH shortened statutory period, then the shortened statutory period will expire on the date the advisory action is mailed, and any extension fee pursuant to 37 CFR 1.136(a) will be calculated from the mailing date of the advisory action. In no event, however, will the statutory period for reply expire later than SIX MONTHS from the mailing date of this final action.

11. Any inquiry concerning this communication or earlier communications from the examiner should be directed to Clark F. Dexter whose telephone number is (571)272-4505. The examiner can normally be reached on Mondays, Tuesdays, Thursdays and Fridays.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Boyer D. Ashley can be reached on (571)272-4502. The fax phone number for the organization where this application or proceeding is assigned is 571-273-8300.



Art Unit: 3724

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free). If you would like assistance from a USPTO Customer Service Representative or access to the automated information system, call 800-786-9199 (IN USA OR CANADA) or 571-272-1000.

**/Clark F. Dexter/  
Primary Examiner, Art Unit 3724**

cfd  
July 21, 2008